

Appl. No.: 09/475,500  
Applicants: Daniel C. Notarnicola  
Filed: December 30, 1999  
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### REMARKS

As suggested by the Examiner, the Applicant makes only a minor amendment to Claim 40 to delete the word "of." Independent Claim 40 is otherwise the same as previously presented. The Applicant adds new claims 46-54, all of which are dependent claims reciting features of the invention disclosed in the original specification.

The Examiner rejects Claims 40 and 45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,211,308 (Decker, 1993) in view of U.S. Patent No. 4,905,868 (Beane, 1990), or vice versa (*i.e.*, the Beane '868 patent in view of the Decker '308 patent). Given that the Examiner considers either reference sufficient to serve as the primary reference in the Office Action, the Applicant addresses the combination of these references in one discussion.

*the "unobstructed passageway"*

In the immediately prior amendment, the Applicant incorporated a recitation into the claim for an unobstructed passageway from the centralized opening to the outlet of the dispenser. The Applicant respectfully contends that this amendment distinguishes the present claims from the Decker '308 patent.

In this regard, the Decker '308 patent fails to show or suggest any embodiment of a towel dispenser without the disclosed spherical ball (Ref. No. 54) within the dispensing funnel (Ref. No. 30). Significantly, Decker states:

The ball 54 is located in the ball seat 53 and lightly engages the rear side of the leading end portion of the paper. When the free end of the paper is pulled downwardly, the ball spins to reduce friction against the paper and assist the paper in moving through the dispensing port 50. The dispensing port imparts resistance against the paper and, as more paper is pulled downwardly and the arc of the person's arm changes, the resistance together with the angle of the lower end portion 40 of the funnel 30 causes a wiper to tear away from the paper along the perforations . . .

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(column 4, lines 50-55). Accordingly, Decker teaches that the gliding action of the ball minimizes friction within the dispensing funnel. Decker specifically teaches that the combination of the dispensing funnel's design and the user's natural arm motion creates a sufficient frictional force to tear the towel only at the dispensing port (Ref. No. 50).

In direct contrast to Decker's teaching with respect to the use of a ball to reduce friction along the towel dispensing route (*i.e.*, within the funnel), the Beane '868 patent teaches a funnel shape that increases friction within the funnel. Bean states:

[C]one shaped funnel portion 16b acts to compress the paper towel as it travels from the entrance opening 20 to the exit opening 18. As the paper towel compresses, friction increases between the inside wall of cone-shaped portion 16b and the paper towel itself. This increased friction increases the resistance force on the towel as it is extracted from exit opening 18. Eventually, the friction between the paper towel and the funnel 16 reaches a point where the resistance force on the towel exceeds the force required to break the paper towel along its perforation boundary.

(column 4, lines 36-46).

The Decker '308 patent and the Beane '868 patent teach entirely different structures to impart entirely different physical principles in order to achieve a reliable towel tear. Beane teaches increasing the force of friction throughout the dispensing path in the funnel. Decker, on the other hand, teaches reducing friction along the funnel path, and instead relies on localized friction at the outlet port to tear the towel.

The Applicant respectfully notes that, as set forth in the MPEP, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." See MPEP § 2143.01.

Therefore, given the different structural parameters that Beane and Decker teach to achieve their respective operable devices, the Applicant respectfully asserts that the Examiner's combination of these references is inapt. There is simply no motivation to

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combine two such references having incongruous principles of operation to achieve the patentable invention that the Applicant claims.

*the angled nozzle*

The Examiner further contends that it would have been obvious for one of skill in the art to modify the unobstructed towel path of the Beane '868 patent by angling the nozzle as disclosed in the Decker '308 patent. The Beane '868 patent disclosure, however, teaches directly against such a combination by stating:

In the present embodiment, it is advantageous for the entire structure of nozzle 8 to be symmetrical with respect to a longitudinal axis passing therethrough. This ensures that reliable towel dispensing may be conducted from any angle or any position with respect to the towel container.

(column 4, line 66–column 5, line 3). Although the Examiner relies upon the "references themselves" to provide the motivation for combining the disclosures, the Applicant respectfully states that the above-quoted language in the Beane patent proves otherwise. Beane requires a symmetrical, non-angled outlet nozzle to achieve its objectives. Indeed, as noted, the Beane patent not only fails to provide any suggestion to incorporate the angled nozzle of the Decker '308 patent, but also specifically teaches against such a change.

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### CONCLUSION

The Applicant respectfully asserts that the Examiner's combination of the Decker '308 patent and the Beane '868 patent is inapt and thus cannot preclude the allowance of Claims 40 and 45. The Examiner attempts to use these references in an effort to show the obviousness of certain recitations of independent Claim 40, but the plain language of these patents precludes their combination for this purpose. Accordingly, the Applicant respectfully states that the previously pending Claims 40 and 45 are in proper condition for immediate allowance and respectfully requests the same. The Applicant's newly added dependent claims are likewise allowable as they all ultimately depend from independent Claim 40.

The appropriate fees for this filing and a one month extension of time are being paid by credit card. If additional fees are required or if any credits are due, the Examiner is hereby authorized to charge Deposit Account No. 50-0332.

Respectfully submitted,



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